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REMARKS

Claims 1-4 and 13-16 remain in this application and are rejected. Claims 5-12 and 17-24 are previously cancelled herein. Claim 1 is amended herein to clarify the invention.

CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1, 2, 13 and 14 are rejected under 35 U.S.C. §103(a) as obvious over the Mozur, von Bauer, Scott, and Setlak references. The applicant herein respectfully traverses this rejection. For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

In the Amendment filed February 4, 2005, it was noted that the prior art failed to disclose the call button or message button being conductive to discharge static electricity. The Examiner now contends that the conductive call or message button is obvious in view of Setlak teaching that part of a fingerprint input sensor has a discharge area.

It is respectfully submitted that a *prima facie* case of obviousness cannot be established in rejection of amended claims. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion

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or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection".

As noted above, the references must teach each element of the present invention and provide a teaching to make the claimed combination. The Examiner notes that the Setlak reference "discloses a part of the fingerprint sensor is made of conductive material (ESD suppressor, Fig. 3, 101 is connected to the first electrode, Fig. 3, 54) and is grounded (ground, Fig. 3), and the part of the fingerprint sensor unit is made of conductive material is touched by a person before inputting the person's fingerprint into the fingerprint input means to release static electricity from the person." The Examiner then conclusively states that it would be obvious to modify the cited art to "provide a fingerprint sensor package which is resistant to transients such as ESD events."

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The rejection is deficient in two respects. It is first noted that the Setlak reference teaches that a discrete separate area 54 whose sole purpose is for discharge is used to discharge the user. The area 54 is not a button to be pressed for accomplishing a function other than discharge. In the Setlak reference the unit 71 is the fingerprint input device and is separate from the discharge area electrode 54. As such, the claimed dual function element of either the call or message button of claim 1, which is integrated with a static discharge function by virtue of being conductive and grounded, is not taught by the Setlak reference.

Second, there is no motivation or suggestion to arrive at the dual function element claimed in claim 1. Neither Setlak nor any of the other references indicate that a discharge area may have another function besides discharge. Still further, there is no suggestion that such a button used for grounding be a button for calling or leaving a message which is a necessary button for a caller to use. It is well settled that features of prior art references may not be assembled to establish obviousness using the pending claims as a template. Indeed, the court in *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992) stated that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." Thus, the prior art references must suggest some desirable attribute for making the proposed combination and not just provide an alternative possibility

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for an assembled assortment of features. The Examiner has merely set forth a possible combination of different features but has failed to show how the references suggest such a combination. Absent such a showing, the obviousness rejection is not sufficiently supported to establish a *prima facie* case of obviousness.

Applicant additionally offers the following observations regarding the patentability of the claims and advantages of the invention. The present invention of claim 1 includes features that an outdoor unit has a call button and message input button each for being pushed by the finger, and at least the call button or message input button is made of conductive material and grounded so that a part for static discharge is integrated with the one of the buttons.

On the other hand, Setlak has a first external electrode 54 as a part of the fingerprint sensor package 30. However, the first external electrode 54 is not integrated with any button to be pressed by a finger, but is merely an electrode fixed on a surface of a housing 51 of the fingerprint package 30 as a special part for static discharge.

The present invention of claim 1 utilizes the existing call button or existing message button to be integrated with a part for static discharge, so that the call button or message button serves as a guide ensuring discharge of the static electricity because the call button and message button are initially pressed by the user's finger there; therefore exists the basic premises that the buttons are contacted by the

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finger. Namely, the call button and message button have enough size and shape to be contacted by a finger to ensure static discharge.

Still further, utilizing the existing call button or existing message button to integrate with a part for static discharge avoids adding a special part for static discharge to the outdoor unit and simplifies the wireless call system. It also increasing a size of the fingerprint input means and the wireless call system while it can effect static discharge as mentioned above. Additionally, when repairing the static discharge feature, one only has to replace the button with new one. Therefore, maintenance efficiency is increased and maintenance cost reduced.

On the other hand, Setlak has a first external electrode 54 as a part of the fingerprint sensor package 30. However, the first external electrode 54 is not integrated with any button being pushed by finger, but is merely an electrode fixed on a surface of a housing 51 of the fingerprint package 30 as a special part for the static discharge. Therefore, Setlak needs to provide the housing 51 with a special space for the first external electrode 54, so that the fingerprint sensor package 30 enlarges due to the space. When repairing the first external electrode 54 for static discharge by replacement with a new one, one must replace the fingerprint sensor package 30 as a whole with new one. This reduces maintenance efficiency and increases maintenance cost.

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Accordingly, even if Setlak, Mozer, Bauer, and Scott are combined, the structure utilizing the existing button integrated with a part for static discharge is not suggested. A special part for static discharge would merely be affixed to a housing of a fingerprint scanner.

In this case, the part for static discharge needs have enough size and a shape to permit finger contact for the static discharge. This enlarges the fingerprint scanner and the device as a whole and complicates the structure of the device. In addition, when repairing the part for static discharge by replacement with a new one, one needs to replace the fingerprint scanner as a whole with new one in the Setlak embodiment.

Claims 3, 4, 15 and 16 are rejected under 35 U.S.C. §103(a) as obvious over the Mozer, von Bauer, Scott, and Setlak references and further in view of the Nakamura reference which is cited for teaching the image recording means. However, the recording is done in a unit corresponding to the outdoor unit and not the indoor unit. Additionally, the Nakamura and von Bauer references rely on a user's television set for displaying the images from outside and uses a controller separate from the television set for controlling the door lock. Thus, the combination of references does not lead one to incorporate a video display into a handheld indoor unit for controlling the door lock and messaging functions.

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Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited references for the reasons stated above. Reconsideration of the rejections of the claims and their allowance are respectfully requested.

REQUEST FOR EXTENSION OF TIME

Applicant respectfully requests a one month extension of time for responding to the Office Action. The fee of \$120.00 for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

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In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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